THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES P. HAMLEY

Appeal No. 1997-3822
Application No. 08/406,668[1]

ON BRIEF

Before MARTIN, JERRY SMITH, and BARRETT, Administrative Patent Judges.

MARTIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2,

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[1] Application for patent filed March 20, 1995.

5-9, and 11-33 under 35 U.S.C. § 103. Claim 10 stands objected to for depending from a rejected claim. We reverse.

A. The invention

The invention is a telephone system which can be used to (a) make or receive a normal telephone call and (b) send or receive a voice-mail message.

B. The claims

The independent claims are claims 1, 5, 14, and 24, of which claim 14, one of the broader claims, reads as follows:

> 14. A telephone control system permitting a caller to selectively transmit either a standard telephone transmission or a voice-mail message to a called party at the called party's single address, the system comprising:
>
> selector means for permitting a caller to select either a standard telephone transmission or a voice-mail message;
>
> processing means for storing a caller's voice-mail message in the event the caller selects a voice-mail message; and
>
> transmission means for placing a call to said called party at said called party's single address and, in the event the caller has selected a voice-mail message, transmitting to the called party said stored voice-mail message, otherwise, processing said call as a standard telephone transmission.

C. The references and rejections

The examiner's rejections are based on the following prior art:

Nagata et al. (Nagata)	4,677,657	Jun. 30, 1987
Perelman	5,274,696	Dec. 28, 1993

Claims 1, 2, 5-9, 11, 14-21, and 24-31 stand rejected under § 103 for obviousness over Nagata.

Claims 12, 13, 22, 23, 32, and 33 stand rejected under § 103 for obviousness over Nagata in view of Perelman. Because none of these claims are separately argued, it is not necessary for us to consider Perelman.

D. The merits of the rejection based on Nagata alone

Nagata's Figure 6 shows a communication system which employs transmitting and receiving apparatuses 3 and 3' having respective slots 31 for receiving cards 1 and 1', each of which cards includes a memory 22 (Fig. 3) for storing voice-mail messages and other circuitry for writing messages into and reading messages out of the memory. Transmitting and receiving apparatus 3 (Fig. 6) includes a handset 32 and keypad 33, permitting it to be used as an ordinary push-button telephone (col. 7, lines 5-7). If the capability of handling ordinary telephone calls is not desired, the handset and keypad can be omitted, resulting in the transmitting and receiving apparatus identified as 3' in Figure 6 (col. 7,

lines 31-36). Apparently based on Nagata's suggestion that the telephone device at the receiving end can take the form of a device 3 or a device 3' (col. 8, lines 57-65),[2] the examiner contends (Answer at 4) that it would have been obvious to replace transmitting device 3' of Figure 6 with a device like device 3, which includes a handset, keypad, and indicator lamp and thus is capable of being used to receive ordinary telephone calls. Hereinafter, the device that replaced device 3' will be referred to as "the receiving telephone device" and the other device as "the transmitting telephone device." However, the card at the receiving end will continue to be identified as 1'.

Each of the telephone devices 3 also includes an indicator lamp 34 which "serves to indicate the operation state of the transmitting and receiving apparatus 3. For example, the indication lamp 34 blinks during the transmission or reception of the message or it is turned on when the transmission or reception by the card is completed." (Col. 7,

[2] In view of this suggestion, the examiner need not have argued (Answer at 4) that it would have been obvious to replace device 3' with a device like device 3.

lines 17-21.) Nagata does not explain how the transmitting and receiving apparatus 3 determines that a message is being or has been transmitted or received.

The information stored in memory 22 of card 1 for transmission to card 1' includes: (a) the calling party's "registered number," which may be his telephone number (col. 7, lines 65-67); (b) the telephone number of the other party (col. 8, line 11); and (c) the message (col. 8, line 14). The information can be transmitted in digital form (Fig. 3; col. 6, lines 17-21) or analog form (Fig. 5; col. 6, lines 21-30).

In order to transmit the message previously recorded on card 1, the operator inserts the card into slot 31 of the transmitting telephone device, which in a first embodiment transmits the message from memory 22 of the card to memory 41 (Fig. 4) in exchanger 4, where it is held until the intended recipient inserts his card 1' into slot 31 of the receiving telephone device, at which time the message is forwarded from memory 41 in exchanger 4 to the memory 22 of card 1' (col. 7, lines 4-16 and 22-31). Nagata also describes a second embodiment, on which the examiner relies, wherein "[i]nstead of the exchanger 4, a telephone 3 or 3' of the one's own

residence may be used to store the content of a message. A memory device of a transmitting and receiving apparatus 3 or 3' provided for that purpose is indicated as a memory 35 or 35'." (Col. 7, lines 37-41.) Appellant does not dispute the examiner's position that this passage calls for transmitting the message from the transmitting telephone device to the memory 35 in the receiving telephone device (Answer at 4). We note that in describing such an arrangement, Nagata further specifies that "[i]n this case, if a transmitting and receiving apparatus provided with a handset 32 is used, it is made possible to confirm only the message by taking up the handset" (col. 7, lines 41-44). However, Nagata does not disclose any details about the circuitry which controls either recording of the message in memory 35 of the receiving telephone device or playback of the recorded message through the handset.

Turning now to the claims, we note that appellant and the examiner specifically argue the limitations of only claim 1, which is narrower than the other independent claims, i.e.,

claims 5, 14, and 24.[3] However, as will appear, we are reversing the rejection of all of these claims for failure to demonstrate the prima facie obviousness of the "single address" requirement common to all of the independent claims, which requirement the examiner and appellant apparently agree refers to the ability to transmit standard telephone calls and voice-mail messages to a party using a single telephone number for that party. The examiner argues that when voice-mail messages are sent to memory 35 in the receiving telephone device instead of to memory 41 in exchanger 4, the calling party is able to use the same telephone number to reach the receiving telephone device whether making a standard telephone call or sending a voice-mail message to memory 35 (id.). Appellant offers the following reasons why it would not have been obvious to use the same telephone number for both types of communication:

> In *Nagata*, a casual reference is made to the fact that the receiving device 3' could be a standard telephone. Note, however, that there is no teaching

[3] The Brief (at 17-20) recites the limitations of claims 5, 14, and 24 and argues that those claims are patentable over Nagata for the reasons given with respect to claim 1.

> whatsoever in *Nagata* as to how a calling party could opt to either [sic] transmit, at the calling party's option, either a voice-mail message or a standard telephone transmission to the called party at a single address for the called party.
>
> For example, looking at *Nagata*, and applying the Examiner's argument, if a called [sic, calling] party wishes to transmit the digital signal from a stored message to the receiving party, the Examiner suggests that the transmitting party would transmit the digital signal right off of the card, sending it to the receiving party at one address for the receiving party. Now, the receiving party's telephone would ring and the receiving party would have no idea as to whether or not the incoming call was a digital transmission or the calling party with a standard telephone transmission. Thus, the receiving party might answer the phone and be greeted with a series of digital impulses. This, of course, would not be an acceptable situation.
>
> Similarly, at the receiving site, when the phone rings, the receiving party might think it is receiving a digital transmission, not answer the phone, and thereby miss a standard telephone transmission.
>
> [Brief at 14-15.]

In our view, the foregoing problem, which was not addressed in the Answer, must be resolved by the examiner in order to satisfy his burden to make out a prima facie case for obviousness. A related question, not raised by appellant, is how the receiving telephone device would recognize voice-mail messages in order to cause them to be recorded in memory 35. In other words, what is it that corresponds to the claimed identifier tag and means for detecting the identifier tag of

claim 6? In the absence of satisfactory answers to these questions, we are unable to sustain the rejections as to of any of the appealed claims.[4]

We have, however, found several of appellant's other arguments unpersuasive. The first is that "*Nagata* is addressed to a problem quite different and distinct from that addressed by applicant's invention" in that "[i]n *Nagata*, a means is provided for a user to store a message on a card that he or she carries" (Brief at 10). Be that as it may, appellant has not cited any claim language which precludes recording the claimed voice-mail message on a card. Likewise, we do not agree that "there is clearly no teaching in *Nagata*, nor even remote suggestion, of a voice-mail transmitter which

[4] We note that while claims 14 and 24 call for "storing a caller's voice-mail message in the event the caller selects a voice-mail message," they do not require that this storage operation occur at the site of the called party and thus do not preclude the storage operation from being read onto Nagata's technique of storing the voice-mail messages in memory 41 of exchanger 4. However, in order to read these claims onto this technique, the examiner would still have to explain how the same telephone number can be used for both types of transmissions, including how the exchanger distinguishes between voice-mail messages (which are to be stored) and standard telephone calls (which are to be transmitted).

includes a user command input device for requesting a voice-mail transmission rather than a standard telephone mode transmission" (Brief at 12), as recited in claim 1. Appellant has not explained, and it is not apparent to us, why the claimed user command input device cannot be read onto card 1, as argued by the examiner (Answer at 8), which implicitly treats the card and the transmitting telephone device as the claimed transmitter. Nor has appellant explained why the "selector means" of claims 5 and 14 and the step of "permitting a caller to select" in claim 24 are not satisfied in the same way.

REVERSED

JOHN C. MARTIN Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LEE E. BARRETT Administrative Patent Judge	)	

JCM:tdl

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